



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-0460
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,216	07/05/2000	Roland D. Tai	1624.001A	4737

7590 01/07/2005
McDermott Will & Emery LLP
600 13th Street NW
Washington, DC 20005-3096

EXAMINER

LAstra, DANIEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,216

Applicant(s)

TAI, ROLAND D.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-42,45-49,52 and 53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-42,45-49,52 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 40-42, 45-49, 52 and 53 have been examined. Application 09/610,216 has a filing date 07/05/2000 and is a continuation of 09026289 (02/19/1998)

Response to Amendment

2. In response to Advisory action filed 08/30/04, the Applicant filed an RCE, amended claims 40, 45, 47 and cancel claims 18, 43, 44, 50 and 51.

Claim Objections

3. Claim 40 is objected to because of the following informalities: Claim 40 recites "information indicative of a the identity of the promotion carrier". The claim should read "information indicative of the identity of the promotion carrier" . Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 40-42, 45-49, 52 and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter (i.e., "reusable printed promotion carrier") which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 40-42, 45-49, 52 and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter (i.e., "reusable printed promotion carrier") which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40, 41, 46-48 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 5,995,942) in view of Day (US 6,484,146) and further in view of Blank (US 5,531,482).

As per claim 40, Smith, Day and Blank teach:

A system for providing promotions comprising:

a reusable printed promotion carrier which carries information corresponding to a plurality of promotions, the promotion carrier having a machine readable code thereon which identifies the promotion carrier, each promotion being associated with a product, each product having a machine readable product code (see Smith figure 6, column 5, lines 24-26; column 8, lines 1-10). Smith fails to teach a reusable printed promotion carrier. However, Blank teaches a reusable printed promotion carrier (see figures 3, 4b, 6b, column 5, lines 54-67). Therefore, it would have been obvious to a person of

ordinary skill in the art at the time the application was made, to know that Smith would print the plurality of promotions (see Smith figure 6) in a reusable printed promotion carrier, as taught by Blank (see Blank figure 6b). Using a removable and reusable promotion carrier, as taught by Blank in the Smith system would have the advantage of associating a coupon with a particular transaction and with a particular customer.

Smith teaches a reading device capable of reading the machine readable code and machine readable product codes, and configured to provide a data signal bearing information indicative of a the identity of the promotion carrier and the identity of a plurality of selected products (see Smith column 5, lines 24-26; column 7, lines 55-62; column 8, lines 1-10); and

a computer facility capable of receiving the data signal and configured to determine if the promotion carrier contains a redeemable promotion for a product of the plurality of selected products (see Smith column 8, lines 1-10),

Smith fails to teach:

wherein the data signal contains a promotion carrier data signal bearing information indicative of an identity of the promotion carrier presented to the reading device, and the computer facility determines if there are valid promotions contained on the promotion carrier, wherein the computer facility determines if a detected promotion on the promotion carrier has already been presented in a completed transaction, and identifies the detected promotion as a valid promotion if it has not already been presented in a completed transaction. However, Day teaches that a household may receive reward offer and can take advantage of combined purchasing power (see

Art Unit: 3622

column 6, line 55 – column 7, line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to identify promotions as valid if not already presented in Smith in order to allow a household to participate in the reward offer while preventing double couponing (using the same offer more than once).

As per claim 41, Smith, Day and Blank teach:

The system of claim 40, wherein the machine readable code is a bar code and the reading device is a bar code reading device (see Smith figure 6).

As per claim 46, Smith, Day and Blank teach:

The system of claim 40, further comprising a data analysis facility which is configured to analyze the data signal to determine predetermined aspects of the use of the promotion carrier (see Smith column 8, lines 12-20).

As per claim 47, Smith, Day and Blank teach:

A method for providing promotions comprising:

reading information from a machine readable code on a reusable printed promotion carrier which carries information corresponding to a plurality of promotions, the machine readable code identifying the promotion carrier, each promotion on the promotion carrier being associated with a product,

reading machine readable product codes of one or more selected products, the product codes identifying an associated selected product;

providing a data signal bearing information indicative of the identity of the promotion carrier and the identity of a plurality of selected products;

determining if the promotion carrier contains a redeemable promotion for a product of the plurality of selected products based on information in the data signal. and

determining if a detected promotion on the promotion carrier has already been presented in a completed transaction and identifying the detected promotion as a valid promotion if it has not already been presented in a completed transaction. The same rejection applied to claim 40 is applied to claim 47.

As per claim 48, Smith, Day and Blank teach:

The method of claim 47, wherein the machine readable code is a bar code. The same rejection applied to claim 41 is applied to claim 48.

As per claim 53, Smith, Day and Blank teach:

The method of claim 47, further comprising the step of analyzing the data signal to determine predetermined aspects of the use of the promotion carrier. The same rejection applied to claim 46 is applied to claim 53.

Claims 42, 45, 49 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 5,995,942) in view of Day (US 6,484,146) and further in view of Blank (US 5,531,482) and De Lapa (U.S. 5,353,218).

As per claim 42, Smith, Day, Blank and De Lapa teach:

The system of claim 40, wherein the data signal contains a product data signal bearing information indicative of an identity of the plurality of selected products and the computer facility determines a purchase price of the selected products (see De Lapa column 8, lines 10-15). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to have configured the computer

Art Unit: 3622

facility in Smith to identify the plurality of selected products and purchase prices of the selected products as in De Lapa since performing these steps at a computer facility would have been adopted for the intended purpose of product look up and payment generation in Smith.

As per claim 45, Smith, Day, Blank and De Lapa teach:

The system of claim 42, further comprising a check out terminal associated with the reading device and configured to receive payment for the selected products, wherein the computer facility is configured to generate a subtotal purchase price for the selected products, subtract valid promotions from the subtotal purchase price to generate a customer bill, and provide the customer bill to the check out terminal (see De Lapa column 8, lines 10-15). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to have configured the computer facility in Smith to generate the subtotal, discount, and bill as in De Lapa since performing these steps at a computer facility would have been adopted for the intended purpose of product look up and payment generation in Smith.

As per claim 49, Smith, Day, Blank and De Lapa teach:

The method of claim 47, wherein the data signal contains a product data signal bearing information indicative of the identity of the plurality of selected products and the method further comprises the step of determining a purchase price of the selected products. The same rejection applied to claim 42 is applied to claim 49.

As per claim 52, Smith, Day, Blank and De Lapa teach:

The method of claim 49, further comprising the steps of generating a subtotal purchase price for the selected products, subtracting valid promotions from the subtotal purchase price to generate a customer bill, and providing the customer bill to a check out terminal. The same rejection applied to claim 45 is applied to claim 52.

Conclusion

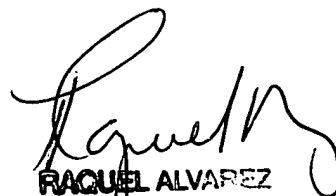
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
December 27, 2004


RAQUEL ALVAREZ
PRIMARY EXAMINER